



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,787	06/28/2001	Takehiko Shioda	041514-5127	9628

55694 7590 02/02/2007
DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER

LOFTUS, ANN E

ART UNIT	PAPER NUMBER
----------	--------------

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

02/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	09/892,787		SHIODA ET AL.	
	Examiner		Art Unit	
	Ann Loftus		3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/28/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20 and 32-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 32-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20/24/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 20 and 32-47 are rejected under U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to the MPEP 2106, section IV, an eligible invention either “physically transforms an article or physical object to a different state or thing, or ... produces a useful, concrete and tangible result.” An invention of a machine or device must still produce one of these results to be patentable. “The scope of 35 U.S.C. 101 is the same regardless of the form or category of invention in which a particular claim is drafted: AT&T, 172 F.3d at 1357, 50 USPQ2d at 1451. See also State Street, 149 F.3d at 1375, 47 USPQ2d at 1602”. Data is not an article or physical object, therefore the invention in claim 20 does not transform an article or physical object.

The MPEP 2106 IV C (2) gives the following guidance to judge whether a result is useful, tangible and concrete:

- Useful – must be specific, substantial and credible and specifically recited in the claim. If the claim is broad enough to not require a practical application, it must be rejected.
- Tangible – must have a “real-world” result, not abstract.
- Concrete – must have a result that is substantially repeatable or the process must substantially produce the same result again.

Claim 20 is broad enough to not require a practical application. Consider a storage medium containing an incomplete file of garbage information. It could still be combined with its missing information, but the result would not be useful. Consider also a copier used to combine two pieces of scrap paper into a single image and print it. If the pieces were formed by cutting some single sheet in half, then they are complementary pieces. Yet combining them does not necessarily have a useful result.

As an abstract concept, splitting and recombining batches of data happens on many levels throughout applications and file handling services in any computer or network. But no specific use is mentioned in claim 20. Consider a file that has been encrypted with a key. The key could be interpreted as missing data that would restore the file to its original state. But decryption is not mentioned as a specific use.

Claim 20 also lacks a tangible result. Combining split batches of data back into a whole is an abstract concept without a real-world impact.

Claims 39 and 45-47 limit the invention to a practical application with a useful, tangible and concrete result. However, as claim 20 is rejected, all its dependent claims are also rejected.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20 and 32-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

Art Unit: 3694

which applicant regards as the invention. Claims 20, 34, 40, 41, and 45-47 are rejected due to issues addressed below, and the rest are rejected due to inherited limitations of their parent claims.

As to claim 20, the phrase (data) "storage medium reproducing means" is unclear. It brings to mind duplicating CDs or floppies, copying paper flyers or even building file cabinets, which would have little to do with the intended invention.

Claim 20 is also unclear as to how similar the reconstructed data must be to the original to be judged the "original complete information data". The question arises because of the nature of data storage on a computer. Consider a file stored on a network drive that is physically composed of five servers. In order to maximize access speed, the file is broken into several parts across the five servers, and each part is stored in at least two places for redundancy. The file is copied to a flash drive, then copied back to the network drive. Logically, to the user, it remains a single unchanged file. Physically, the storage arrangement might be altogether different. Has it been recombined to reconstruct the original complete information data if it is still in pieces across the servers? It's unclear. As a separate complication, variations in compression algorithms might also result in similar but not duplicate data. Particularly in audio transmissions, a low error rate can be undetectable to the human ear, thus audio files that sound the same might not be the same. Suppose a potential infringer adds a slight variation to the data, such that the reconstruction data varies (undetectably in use) from the original data. Would it be the "original complete information data" because the source sound track was the same? Suppose the original data was an mp3 but the

Art Unit: 3694

reconstructed data used another format? The claim does not specify which of several possible slight differences between data sets would invalidate the "original complete information data."

Note that the examiner does not recognize a difference between "information", "data", and "information data".

As to claim 34, the phrase "charging operation to transmission" is unclear. Expenses are normally charged to an account or a person or an organization.

As to claims 40 and 41, the term "trail listening" doesn't apply to the invention. The examiner will presume that "trial listening" was intended.

As to claim 45, there is some confusion between terms of computer science and geography, as the terms "map data" and "addresses" can have multiple meanings. The claim lacks an indication that the map referred to is a geographic map and not a database data map. If that were clarified, then an ordinary person would interpret the addresses as street addresses, and not computer memory addresses.

As to claim 46 and 47, an infringer could claim that their map display did not actually navigate the vehicle, and therefore was not a "navigation device", but rather a navigation aid. The metes and bounds of the patent protection desired are unclear, thus the claims are rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3694

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20, 32, 33 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax software, as described on a web page from 4/24/99 archived at:

http://web.archive.org/web/19990424160122/www.intuit.com/support/turbotax/98faqs/index/ndxw_updates.html. The page is about program updates for 1998, and will be referred to as TurboTax.

Referring to claim 20, tax software is sold year-round as base software with the promise of an early Spring update that will include all the latest tax changes for that year. Before the updates are made available, they are combined with the base software into a complete original for testing. The base software is generally sold on a data storage medium such as a compact disc or floppy disk, and used on a terminal device such as a computer. The computer includes:

- means for reading information data recorded in the storage medium that has recorded incomplete information data obtained by partly omitting complete information data;
- means for receiving complementary information data to complement the incomplete information data, thereby reconstructing original complete information data;

Art Unit: 3694

- and combine means for combining the incomplete information data read from the storage medium with the complementary information data received by the reception means to reconstruct the original complete information data.

The TurboTax reference teaches the updates available in 1999 for the tax year 1998. It does not teach a complete original before the distribution of the base software. While that would be a slight difference in the process, it would not make a difference to the terminal device, which is the claimed invention. The terminal device is reading the base software, receiving the update, and combining the two. It would have been obvious to a person of ordinary skill in the art at the time of the invention that in the case of spring sales, if the updates were available before the base software was sold, but after a complete original had been formed for testing, that the complete original could still be split into base software plus updates and recombined in order to use a proven install/update method and not rewrite and retest the install instructions. It would also preserve the opportunity for further updates, and reassure the customer of possessing the latest version.

As to claim 32, official notice is taken that the computer as above would have the means to replay the updated software, which is the data combined by the combine means, in the case of TurboTax software.

As to claim 33, TurboTax teaches selection of updates to its 1996 and 1997 versions by clicking on the appropriate link. The browser is a selection means for selecting at least one incomplete information data and transmitting a request signal to an information administration device to send complementary information data

Art Unit: 3694

corresponding to the selected data. TurboTax teaches an automatic updater for 1998, which applies updates to all detected installed software (sets of incomplete data recorded on the storage medium, which in this case is the hard drive). It would have been obvious for a person of ordinary skill in the art at the time of the invention to provide an updater that detected the installed software and then allowed the user to select from among sets of incomplete information data on the storage medium, in order to prevent the user from trying to obtain updates to software not installed.

As to claim 36, official notice is taken that it is old and well known for software such as TurboTax to be assigned a serial number or license key, which is transmitted to an information administration device by a browser through a registration process.

As to claim 37 and 38, the computer running TurboTax would teach a browser that could transmit a notice to the information administration device. It is old and well-known for such a device to generate a notice of data combine completion to notify the user that the combine means had completed the data combine operation. TurboTax does not teach (to my knowledge) transmitting the notice of data combine completion back to the information administration device. It would have been obvious to a person of ordinary skill in the art to transmit the notice to the information administration device in order to track successful combine operations.

7. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax software in view of CDNow.com. The home page from 4/27/99 is

Art Unit: 3694

archived at <http://web.archive.org/web/19990427211435/www.cdnow.com/cgi-bin/mserver/redirect/leaf=>

As to Claims 34 and 35, TurboTax teaches the parent claims as above. CDNow teaches VISA for payment of online purchases. The user financial information, in this case credit card information, would be transmitted to the information administration device so that the information administration device can perform a charging operation prior to transmission (whether by network or shipping) of the information data. If there were a charge for TurboTax updates, it would have been obvious to a person of ordinary skill in the art at the time of the invention to arrange for the browser of the computer terminal device to be used to transmit the user credit card or other financial information to the information administration device because this allows rapid online payment and delivery for items comprised of data.

8. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax software in view of mp3.com. The home page of mp3.com from 1/25/99 is archived at:

<http://web.archive.org/web/19990125090950/http://mp3.com/>

As to claim 39, TurboTax teaches combining data received with data on a storage medium. Mp3.com teaches receiving music data of songs. Official notice is taken it is old and well-known that downloading occurs in pieces which are then reconstructed into information data sets in usable form. For example, an HTML page might consist of several images and a base page, which are received and assembled into a display by the browser and monitor. At a lower level, an image might be broken into several data

Art Unit: 3694

packets, and routed various ways and received at various times. Thus if the computer has all but one packet in its storage medium, it will receive the complementary information data packet, and combine it with the rest to reconstruct the original complete information data. Then the computer is used to replay the songs in accordance with the complete music file created. This is how songs are downloaded from mp3.com.

Mp3.com does not teach the simultaneous storage of several incomplete songs. TurboTax does teach simultaneous versions of software that all need updates, such as state tax software, or the personal and business versions. It would have been obvious to a person of ordinary skill in the art at the time of the invention that several songs could be stored as incomplete music files then combined with complementary missing data to form complete files, and then played on the computer because that would allow the computer to optimize the downloads, perhaps by working on the fastest one first.

9. Claims 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax software in view of mp3.com and further in view of CDNow. The home page of CDNow from 4/27/1999 is archived at

<http://web.archive.org/web/19990427211435/www.cdnow.com/cgi-bin/mserver/redirect/leaf=>

As to claims 40 and 41, TurboTax teaches combining data received with data on a storage medium. Mp3.com teaches downloading songs and replaying them on a computer. Mp3.com does not teach trial listening. CDNow includes trial listening in the form of sound clips that allow listeners to listen to incomplete samples of music in the

Art Unit: 3694

form of a few songs from the CD. The sound clips would use replay means on the computer. It would have been obvious to a person of ordinary skill in the art at the time of the invention to add trial listening to any form of music delivery system, in order to make it easy for listeners to try new music. The combination of the trial listening feature and the method of combining data on a storage medium with data received does not confer unexpected advantages.

As to claim 42 and 44, mp3.com teaches displaying a list of songs on an information administration device.

As to claim 43, mp3.com's list of songs would be recorded in the browser cache of the hard drive depending on the browser settings. Thus the list would be recorded in a storage medium on the device with the reading means, the combining means and so on. Mp3.com does not teach recording a list of songs alongside the songs recorded on the storage medium, because there was mp3 player software that recompiled the list from the data and displayed it for the user. It would have been obvious to a person of ordinary skill in the art at the time of the invention to record such a list by saving the compiled display if a historical record of which songs were available was required.

10. Claims 45, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over TurboTax software in view of the Magellan Mapsend and GPS products, described in a press release from June 30, 1999 at

<http://www.magellangps.com/news/releases/viewRelease.asp?id=122>

Art Unit: 3694

As to claim 45, the article teaches geographic map data on a storage medium. The MAP 410 GPS receiver combines information from the CDs of nautical charts with the GPS information of current and stored locations to display combined data.

As to claims 46 and 47, the GPS teaches a navigation aid, installed on a vehicle, that detects current location and displays a map and a route to a destination.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3694

AL
1/08/07



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINE
TECHNOLOGY CENTER 3600